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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92063839
Party	Plaintiff Mozza, LLC
Correspondence Address	LISA A FERRARI COZEN O'CONNOR 277 PARK AVENUE NEW YORK, NY 10172 UNITED STATES lferrari@cozen.com, tmdocketing@cozen.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Lisa A. Ferrari
Filer's e-mail	lferrari@cozen.com
Signature	/Lisa A. Ferrari/
Date	08/23/2016
Attachments	Mozza LLC - Motion for Leave to Amend.pdf(2004209 bytes) Mozza LLC - Brief in Support of Motion to Amend.pdf(514781 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3,975,466

Registered: June 7, 2011

Mark: MOZZA MIA

MOZZA, LLC,

Petitioner,

v.

PARASOLE IP, LLC,

Registrant.

Cancellation No. 92/063,839

**PETITIONER'S MOTION FOR LEAVE TO FILE
AMENDED PETITION FOR CANCELLATION**

Petitioner, MOZZA, LLC ("Mozza" or "Petitioner"), makes this motion seeking leave to file an Amended Petition for Cancellation. A signed copy of the proposed Amended Petition for Cancellation in red-lined format is attached as Exhibit 1 hereto and a clean version of said pleading is attached as Exhibit 2. A brief in support of this motion follows.

Dated: August 23, 2016

Respectfully submitted,

COZEN O'CONNOR

/s/ Lisa A. Ferrari

Lisa A. Ferrari

277 Park Avenue

New York, NY 10172

Tel: (212) 297-2699

Fax: (646) 588-1459

Email: lferrari@cozen.com

Attorneys for Petitioner Mozza, LLC

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that on August 23, 2016, a copy of the foregoing **PETITIONER'S MOTION FOR LEAVE TO FILE AMENDED PETITION FOR CANCELLATION**, with **EXHIBITS 1 and 2**, is being electronically filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, at <http://estta.uspto.gov/>.

/s/ Lisa A. Ferrari

CERTIFICATE OF SERVICE

I hereby certify that on August 23, 2016, copies of the foregoing **PETITIONER'S MOTION FOR LEAVE TO FILE AMENDED PETITION FOR CANCELLATION**, with **EXHIBITS 1 AND 2**, have been served upon Registrant, addressed as follows:

Via electronic delivery (pursuant to agreement)
Larrin Bergman, Esq.
KINNEY & LANGE, P.A.
The Kinney & Lange Building
Minneapolis, Minnesota 55415-1002
Email: LBergman@kinney.com
Attorneys for Registrant Parasole IP, LLC

/s/ Lisa A. Ferrari

EXHIBIT 1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3,975,466

Registered: June 7, 2011

Mark: MOZZA MIA

MOZZA, LLC,

Petitioner,

V.

PARASOLE IP, LLC,

Registrant.

Cancellation No. 92/063,839-

AMENDED PETITION FOR CANCELLATION



MOZZA, LLC (“Mozza” or “Petitioner”), a California limited liability company with a place of business at 45 East 20th Street, 3rd floor, New York, New York 10003, believes that it will be damaged by the continued registration of the mark MOZZA MIA shown in U.S. Registration No. 3,975,466 (the “Registered Mark”), owned by PARASOLE IP, LLC (“Registrant”), a Delaware limited liability company with a place of business at 5032 France Avenue, South Edina, Minnesota 55410, and hereby petitions to cancel same (the “Amended Petition”). Mozza petitions for cancellation on the basis of a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and fraud on the Patent and Trademark Office under Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3). In support of its Amended Petition, Mozza asserts as follows:


MOZZA'S MARKS

1. Mozza owns trademarks that have been continuously used in connection with restaurant and bar services at the world-renowned Pizzeria Mozza, Osteria Mozza, and Mozza2Go restaurants and eateries in Los Angeles, California and elsewhere (the "Mozza Restaurants").

2. The Mozza Restaurants have been operated by Mozza's principals, the world-famous chef/restaurateurs Mario Batali, Joseph Bastianich and Nancy Silverton. The first Mozza Restaurant, Pizzeria Mozza, opened in Los Angeles in 2006, and was followed by Osteria Mozza which opened in 2007, and Pizza Mozza2Go which opened in 2009. Mozza has also opened Mozza Restaurants in Newport Beach, California and outside the U.S.

3. In connection with its operation of the Mozza Restaurants, Mozza owns the following design plus word marks, all of which are legally and validly registered on the Principal Register of the United States Patent and Trademark Office ("USPTO"), and together which are referred to herein as the "MOZZA Registrations":

Registration No.	Mark	Goods/Services and International Class	First Used in Commerce
3,407,311 (M PIZZERIA MOZZA)		"Restaurant and bar services" in Class 43	Nov. 14, 2006
3,386,960 (OSTERIA MOZZA M)		"Restaurant and bar services" in Class 43	July 13, 2007

3,898,988 (M PIZZA MOZZA 2GO)		"Restaurant and bar services" in Class 43	June 30, 2009
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4. The MOZZA Registrations have each attained incontestable status pursuant to 15 U.S.C. §§ 1065 and 1115.

5. In addition to the MOZZA Registrations, Mozza owns extensive common law rights in the mark MOZZA in connection with restaurant and bar services. Mozza has promoted and delivered its restaurant and bar services to a national and international clientele. Mozza owns and operates websites at the domains <http://www.pizzeriamozza.com>, <http://www.osteriamozza.com>, and <http://www.mozza2go.com>, through which it promotes and advertises its restaurant and bar services throughout the United States and elsewhere. As a result of Mozza's wide-ranging promotional activities, Mozza owns extensive common law rights in the mark MOZZA in connection with restaurant and bar services. The marks shown in the MOZZA Registrations, together with Mozza's extensive common law rights, are collectively referred to herein as the "MOZZA Marks."

6. Mozza has expended substantial sums of money in marketing, advertising and promoting its MOZZA Marks and, through such sales and advertising, has generated substantial goodwill and customer recognition in the MOZZA Marks. The public has come to associate the MOZZA Marks exclusively with Mozza.

7. Mozza has derived substantial revenues from the sale of restaurant and bar services under the MOZZA Marks.

8. Mozza's extensive use and advertising of the MOZZA Marks has resulted in consumer recognition that the MOZZA Marks identify Mozza as the source of high-quality food

and wine. The MOZZA Marks are distinctive of Mozza's services and are well known and famous. Valuable goodwill has been generated in the MOZZA Marks, and such goodwill was generated long before the filing date of the Registered Mark.

Registrant's Registration for MOZZA MIA

9. On February 15, 2010, Registrant filed an intent-to-use application to register the mark MOZZA MIA in connection with "restaurant and bar services" in International Class 43. The application was assigned Serial No. 77/935,634.

10. Following the examination and publication of the application by the U.S. Patent and Trademark Office, Registrant was issued U.S. Registration No. 3,975,466, *i.e.*, the Registered Mark, on June 7, 2011.

11. As of the filing date of Petitioner's initial Petition to Cancel, Registrant's Mark ~~lacked~~ incontestable status pursuant to 15 U.S.C. § 1065, 1115.

12. Registrant's use and registration of the Registered Mark in connection with restaurant and bar services was and is without the consent or permission of Mozza.

13. Long before Registrant's first use and filing of the Registered Mark, Mozza adopted, first used, and registered the MOZZA Marks on or in connection with restaurant and bar services. Since then, Mozza has continuously used and not abandoned the MOZZA Marks.

14. The services for which Registrant has registered and uses the Registered Mark are identical to the services in connection with which the MOZZA Marks are used and for which Mozza owns registrations.

Registrant's Improper Filing of Declaration of Incontestability

15. Petitioner filed its initial Petition to Cancel with the Trademark Trial and Appeal Board ("TTAB") on June 6, 2016. On the same day, pursuant to the Board's rules, Petitioner

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sent a copy of said Petition to Cancel, by U.S. Mail, to Registrant and also to its trademark counsel, at the addresses on record in the Patent and Trademark Office ("PTO") database. Petitioner also sent a courtesy copy of said Petition to Cancel to Registrant's trademark counsel at the email address shown in the PTO database. A copy of the email to Petitioner's trademark counsel is attached hereto as Exhibit A.

16. As a result of Petitioner's filing of the Petition to Cancel, there was a proceeding pending involving Registrant's rights to the registration shown in the Registered Mark. Pursuant to 15 U.S.C. §§ 1065(2) and (3), Registrant was therefore prohibited from filing an affidavit or declaration of incontestability. As set forth in section 1065(2), a trademark owner filing an affidavit or declaration of incontestability must state under oath that "there is no proceeding involving said [trademark] rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of."

17. Section 1065(3) requires that said statement, along with the statements that there has been no final decision adverse to the owner's claim of ownership and that the mark has been in continuous use in commerce for five consecutive years, be made in connection with the declaration or affidavit, assuming, of course, that these statements are all accurate. These three statements, which are the basis for a registered mark to obtain the status of incontestability, are material to the ongoing registrability of the mark.

18. Upon information and belief, despite having received actual notice of Petitioner's Petition to Cancel the day before, Registrant, on June 7, 2016, proceeded to file a Declaration of Use and Incontestability. As part of this filing, Registrant's counsel signed a declaration under oath, on behalf of Registrant, stating that "no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exist." Said statement

was false at the time it was made and, upon information and belief, was known to Registrant, through its counsel, to be false.

19. Since June 7, 2016, the date on which Registrant made its improper filing, Registrant has taken no steps to withdraw the improper filing or otherwise correct the records of the USPTO concerning the Registered Mark. Thus, even if Registrant's counsel did not review her email on June 6, 2016, and even if Registrant received actual notice of Petitioner's Petition to Cancel after the filing of Registrant's Declaration of Use and Incontestability, Registrant has had ample time to withdraw the improper filing but has taken no steps to do so. Where a party has filed an inaccurate Declaration of Incontestability, the owner may file a petition to the Director pursuant to 37 C.F.R. §2.167(j) requesting that the declaration of incontestability be abandoned. Registrant, however, has filed no such request.

20. Registrant filed its Answer in this proceeding on July 15, 2016, at which time it had taken no steps to withdraw or abandon the improper filing.

21. Registrant's litigation counsel participated in the Initial Discovery Conference with Petitioner on August 5, 2016, at which it had still taken no steps to withdraw or abandon the improper filing. At the time of the discovery conference, Registrant's improper filing was unknown to Petitioner. During the conference, Registrant's counsel stated that Registrant would be willing to delay the cancellation proceeding as long as Petitioner wanted, and inquired as to whether Petitioner would be amenable to such delay. Upon information and belief, Registrant was seeking to delay this cancellation proceeding so as to give the USPTO's Post-Registration Unit time to accept Registrant's improper filing.

22. The USPTO acted on Registrant's Declaration of Use and Incontestability on August 19, 2016, at which time the USPTO's Post-Registration Unit incorrectly accepted

Registrant's filing despite the pendency of this proceeding. Thus, from June 7, 2016, until August 19, 2016, a period of more than two months, Registrant took no steps to withdraw or correct the improper Declaration of Incontestability, but instead allowed the filing to remain on the USPTO docket and be considered by the Post-Registration Unit.

14. —

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COUNT 1 - LIKELIHOOD OF CONSUMER CONFUSION

15.23. Mozza repeats and realleges the allegations of paragraphs 1 through 14.22 above, as though fully set forth herein.

16.24. Mozza has used the MOZZA Marks in United States commerce prior to Registrant's adoption, use of, and application to register the Registered Mark. Mozza registered each of the MOZZA Marks prior to Registrant's adoption, use of, application to register, and registration of the Registered Mark.

17.25. Registrant's mark, MOZZA MIA, is confusingly similar to Mozza's MOZZA Marks.

18.26. Based on the foregoing, the continued registration of the mark MOZZA MIA by Registrant in connection with restaurant and bar services is likely to cause confusion, mistake or deception that Registrant's services are those of Mozza or are otherwise endorsed, sponsored or approved by Mozza, or cause confusion, mistake or deception as to the affiliation, connection or association between Registrant and Mozza.

19.27. If Registrant is permitted to continue to use and register Registrant's Mark in connection with restaurant and bar services, confusion in trade resulting in irreparable damage and injury to Mozza would be caused by reason of the similarity between Registrant's Mark and

Mozza's MOZZA Marks. Consumers are likely to buy Registrant's services incorrectly believing that such services are provided by, endorsed by or associated with Mozza.

~~20.~~28. If Registrant is granted continued registration of Registrant's Mark, Registrant will maintain a *prima facie* exclusive right to use the Registered Mark, and such continued registration would be the source of irreparable damage and injury to Mozza.

~~21.~~29. Accordingly, the Registered Mark should be cancelled under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), as amended.

COUNT II - DILUTION

22-30. Mozza repeats and realleges the allegation of paragraphs 1 through 24⁹ above, as though fully set forth herein.

23-31. Registrant's commercial use of the Registered Mark in United States commerce in connection with restaurant and bar services dilutes, or is likely to dilute, the distinctive quality and reputation of the MOZZA Marks under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

24-32. Upon information and belief, Registrant's use of the Registered Mark commenced after the date on which Petitioner's MOZZA Marks became famous.

25-33. If Registrant is permitted continued use and registration of the Registered Mark in connection with restaurant and bar services, dilution of the distinctive quality and reputation of Mozza's famous MOZZA Marks would result in irreparable damage and injury to Mozza.

34. Accordingly, Registrant's Mark should be cancelled under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), as amended.

COUNT III – FRAUD ON THE PATENT AND TRADEMARK OFFICE

35. Mozza repeats and realleges the allegations of paragraphs 1-34 above, as though fully set forth herein.

36. Registrant made a false representation to the USPTO when it stated under oath at the time it filed its Declaration of Use and Incontestability that there was no proceeding involving its rights in the Registered Mark pending in the USPTO and not finally disposed of.

37. –Registrant's false representation is material to the registrability of the mark.

38. Upon information and belief, Registrant had knowledge of the falsity of the representation at the time it was made or immediately thereafter.

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39. Upon information and belief, Registrant made the false representation with the intent to deceive the USPTO or, after learning that the statement was false, adopted the false representation with the intent to deceive the USPTO.

~~26-40.~~ Accordingly, Registrant's Mark should be cancelled under Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3), and Registrant's Declaration of Incontestability should be deemed withdrawn during the pendency of this proceeding and refused if later re-filed.

PRAYER FOR RELIEF

WHEREFORE, Petitioner Mozza, LLC prays that the mark shown in U.S. Registration No. 3,975,466 be cancelled, that the Declaration of Incontestability filed by Registrant be deemed withdrawn during the pendency of this proceeding and refused if later re-filed, and that this cancellation proceeding be sustained in Petitioner's favor.

~~Mozza, LLC submits herewith the requisite filing fee in the amount of \$300. The Board is authorized to charge PTO Deposit Account No. 503111 for any additional charges or fees related to this filing.~~

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Dated: ~~June 6~~August 23, 2016

Respectfully submitted,

COZEN O'CONNOR

/s/ Lisa A. Ferrari

Lisa A. Ferrari
277 Park Avenue
New York, NY 10172
Tel: (212) 297-2699
Fax: (646) 588-1459
Email: lferrari@cozen.com

Attorneys for Petitioner Mozza, LLC

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that on ~~June 6~~August 23, 2016, a copy of the foregoing **AMENDED**
PETITION FOR CANCELLATION, with attached **EXHIBIT A**, is being electronically filed
with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, at
<http://estta.uspto.gov/>.

/s/ Lisa A. Ferrari

CERTIFICATE OF SERVICE

I hereby certify that on June 6~~August 23~~, 2016, copies of the foregoing **AMENDED**
PETITION FOR CANCELLATION, with attached **EXHIBIT A**, have been served upon

Registrant, addressed as follows:

Via First Class U.S. Mail, postage prepaid

Parasole IP, LLC

5032 France Avenue

South Edina, Minnesota 55410

Registrant

Via First Class U.S. Mail, postage
prepaid, and electronic delivery (pursuant to agreement)

Jennifer A. Forbes, Esq.

Felhaber Larson Fenion & Vogt P.A.

220 South Sixth Street, Suite 2200

Minneapolis, Minnesota 55402

Email: jforbes@felhaber.com

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Larrin Bergman, Esq.

KINNEY & LANGE, P.A.

The Kinney & Lange Building

312 South Third Street

Minneapolis, Minnesota 55415-1002

Email: LBergman@kinney.com

Attorneys for Registrant Parasole IP, LLC

/s/ Lisa A. Ferrari

EXHIBIT A

Boezi, Mark

From: Ferrari, Lisa
Sent: Monday, June 6, 2016 7:42 PM
To: jforbes@felhaber.com
Cc: Boezi, Mark
Subject: Mozza, LLC v. Parasole IP, LLC: Petition to Cancel
Attachments: MOZZA MIA Petition for Cancellation.pdf

Dear Counsel:

Please see courtesy copy of Petition to Cancel filed today in the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board.

Sincerely,

/Lisa A. Ferrari/



Lisa A. Ferrari
Member | Cozen O'Connor
277 Park Avenue | New York, NY 10172
P: 212-297-2699 F: 646-588-1459
Email | Bio | LinkedIn | Map | cozen.com

EXHIBIT 2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3,975,466

Registered: June 7, 2011

Mark: MOZZA MIA

MOZZA, LLC,)	
)	
)	
Petitioner,)	Cancellation No. 92/063,839
)	
v.)	
)	
PARASOLE IP, LLC,)	
)	
Registrant.)	

AMENDED PETITION FOR CANCELLATION



MOZZA, LLC (“Mozza” or “Petitioner”), a California limited liability company with a place of business at 45 East 20th Street, 3rd floor, New York, New York 10003, believes that it will be damaged by the continued registration of the mark MOZZA MIA shown in U.S. Registration No. 3,975,466 (the “Registered Mark”), owned by PARASOLE IP, LLC (“Registrant”), a Delaware limited liability company with a place of business at 5032 France Avenue, South Edina, Minnesota 55410, and hereby petitions to cancel same (the “Amended Petition”). Mozza petitions for cancellation on the basis of a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), dilution under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and fraud on the Patent and Trademark Office under Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3). In support of its Amended Petition, Mozza asserts as follows:


MOZZA'S MARKS

1. Mozza owns trademarks that have been continuously used in connection with restaurant and bar services at the world-renowned Pizzeria Mozza, Osteria Mozza, and Mozza2Go restaurants and eateries in Los Angeles, California and elsewhere (the "Mozza Restaurants").

2. The Mozza Restaurants have been operated by Mozza's principals, the world-famous chef/restaurateurs Mario Batali, Joseph Bastianich and Nancy Silverton. The first Mozza Restaurant, Pizzeria Mozza, opened in Los Angeles in 2006, and was followed by Osteria Mozza which opened in 2007, and Pizza Mozza2Go which opened in 2009. Mozza has also opened Mozza Restaurants in Newport Beach, California and outside the U.S.

3. In connection with its operation of the Mozza Restaurants, Mozza owns the following design plus word marks, all of which are legally and validly registered on the Principal Register of the United States Patent and Trademark Office ("USPTO"), and together which are referred to herein as the "MOZZA Registrations":

Registration No.	Mark	Goods/Services and International Class	First Used in Commerce
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3,898,988 (M PIZZA MOZZA 2GO)		"Restaurant and bar services" in Class 43	June 30, 2009
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4. The MOZZA Registrations have each attained incontestable status pursuant to 15 U.S.C. §§ 1065 and 1115.

5. In addition to the MOZZA Registrations, Mozza owns extensive common law rights in the mark MOZZA in connection with restaurant and bar services. Mozza has promoted and delivered its restaurant and bar services to a national and international clientele. Mozza owns and operates websites at the domains <http://www.pizzeriamozza.com>, <http://www.osteriamozza.com>, and <http://www.mozza2go.com>, through which it promotes and advertises its restaurant and bar services throughout the United States and elsewhere. As a result of Mozza's wide-ranging promotional activities, Mozza owns extensive common law rights in the mark MOZZA in connection with restaurant and bar services. The marks shown in the MOZZA Registrations, together with Mozza's extensive common law rights, are collectively referred to herein as the "MOZZA Marks."

6. Mozza has expended substantial sums of money in marketing, advertising and promoting its MOZZA Marks and, through such sales and advertising, has generated substantial goodwill and customer recognition in the MOZZA Marks. The public has come to associate the MOZZA Marks exclusively with Mozza.

7. Mozza has derived substantial revenues from the sale of restaurant and bar services under the MOZZA Marks.

8. Mozza's extensive use and advertising of the MOZZA Marks has resulted in consumer recognition that the MOZZA Marks identify Mozza as the source of high-quality food

and wine. The MOZZA Marks are distinctive of Mozza's services and are well known and famous. Valuable goodwill has been generated in the MOZZA Marks, and such goodwill was generated long before the filing date of the Registered Mark.

Registrant's Registration for MOZZA MIA

9. On February 15, 2010, Registrant filed an intent-to-use application to register the mark MOZZA MIA in connection with "restaurant and bar services" in International Class 43. The application was assigned Serial No. 77/935,634.

10. Following the examination and publication of the application by the U.S. Patent and Trademark Office, Registrant was issued U.S. Registration No. 3,975,466, *i.e.*, the Registered Mark, on June 7, 2011.

11. As of the filing date of Petitioner's initial Petition to Cancel, Registrant's Mark lacked incontestable status pursuant to 15 U.S.C. § 1065, 1115.

12. Registrant's use and registration of the Registered Mark in connection with restaurant and bar services was and is without the consent or permission of Mozza.

13. Long before Registrant's first use and filing of the Registered Mark, Mozza adopted, first used, and registered the MOZZA Marks on or in connection with restaurant and bar services. Since then, Mozza has continuously used and not abandoned the MOZZA Marks.

14. The services for which Registrant has registered and uses the Registered Mark are identical to the services in connection with which the MOZZA Marks are used and for which Mozza owns registrations.

Registrant's Improper Filing of Declaration of Incontestability

15. Petitioner filed its initial Petition to Cancel with the Trademark Trial and Appeal Board ("TTAB") on June 6, 2016. On the same day, pursuant to the Board's rules, Petitioner

sent a copy of said Petition to Cancel, by U.S. Mail, to Registrant and also to its trademark counsel, at the addresses on record in the Patent and Trademark Office (“PTO”) database. Petitioner also sent a courtesy copy of said Petition to Cancel to Registrant’s trademark counsel at the email address shown in the PTO database. A copy of the email to Petitioner’s trademark counsel is attached hereto as Exhibit A.

16. As a result of Petitioner’s filing of the Petition to Cancel, there was a proceeding pending involving Registrant’s rights to the registration shown in the Registered Mark. Pursuant to 15 U.S.C. §§ 1065(2) and (3), Registrant was therefore prohibited from filing an affidavit or declaration of incontestability. As set forth in section 1065(2), a trademark owner filing an affidavit or declaration of incontestability must state under oath that “there is no proceeding involving said [trademark] rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of.”

17. Section 1065(3) requires that said statement, along with the statements that there has been no final decision adverse to the owner’s claim of ownership and that the mark has been in continuous use in commerce for five consecutive years, be made in connection with the declaration or affidavit, assuming, of course, that these statements are all accurate. These three statements, which are the basis for a registered mark to obtain the status of incontestability, are material to the ongoing registrability of the mark.

18. Upon information and belief, despite having received actual notice of Petitioner’s Petition to Cancel the day before, Registrant, on June 7, 2016, proceeded to file a Declaration of Use and Incontestability. As part of this filing, Registrant’s counsel signed a declaration under oath, on behalf of Registrant, stating that “no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exist.” Said statement

was false at the time it was made and, upon information and belief, was known to Registrant, through its counsel, to be false.

19. Since June 7, 2016, the date on which Registrant made its improper filing, Registrant has taken no steps to withdraw the improper filing or otherwise correct the records of the USPTO concerning the Registered Mark. Thus, even if Registrant's counsel did not review her email on June 6, 2016, and even if Registrant received actual notice of Petitioner's Petition to Cancel after the filing of Registrant's Declaration of Use and Incontestability, Registrant has had ample time to withdraw the improper filing but has taken no steps to do so. Where a party has filed an inaccurate Declaration of Incontestability, the owner may file a petition to the Director pursuant to 37 C.F.R. §2.167(j) requesting that the declaration of incontestability be abandoned. Registrant, however, has filed no such request.

20. Registrant filed its Answer in this proceeding on July 15, 2016, at which time it had taken no steps to withdraw or abandon the improper filing.

21. Registrant's litigation counsel participated in the Initial Discovery Conference with Petitioner on August 5, 2016, at which it had still taken no steps to withdraw or abandon the improper filing. At the time of the discovery conference, Registrant's improper filing was unknown to Petitioner. During the conference, Registrant's counsel stated that Registrant would be willing to delay the cancellation proceeding as long as Petitioner wanted, and inquired as to whether Petitioner would be amenable to such delay. Upon information and belief, Registrant was seeking to delay this cancellation proceeding so as to give the USPTO's Post-Registration Unit time to accept Registrant's improper filing.

22. The USPTO acted on Registrant's Declaration of Use and Incontestability on August 19, 2016, at which time the USPTO's Post-Registration Unit incorrectly accepted

Registrant's filing despite the pendency of this proceeding. Thus, from June 7, 2016, until August 19, 2016, a period of more than two months, Registrant took no steps to withdraw or correct the improper Declaration of Incontestability, but instead allowed the filing to remain on the USPTO docket and be considered by the Post-Registration Unit.

COUNT I - LIKELIHOOD OF CONSUMER CONFUSION

23. Mozza repeats and realleges the allegations of paragraphs 1 through 22 above, as though fully set forth herein.

24. Mozza has used the MOZZA Marks in United States commerce prior to Registrant's adoption, use of, and application to register the Registered Mark. Mozza registered each of the MOZZA Marks prior to Registrant's adoption, use of, application to register, and registration of the Registered Mark.

25. Registrant's mark, MOZZA MIA, is confusingly similar to Mozza's MOZZA Marks.

26. Based on the foregoing, the continued registration of the mark MOZZA MIA by Registrant in connection with restaurant and bar services is likely to cause confusion, mistake or deception that Registrant's services are those of Mozza or are otherwise endorsed, sponsored or approved by Mozza, or cause confusion, mistake or deception as to the affiliation, connection or association between Registrant and Mozza.

27. If Registrant is permitted to continue to use and register Registrant's Mark in connection with restaurant and bar services, confusion in trade resulting in irreparable damage and injury to Mozza would be caused by reason of the similarity between Registrant's Mark and Mozza's MOZZA Marks. Consumers are likely to buy Registrant's services incorrectly believing that such services are provided by, endorsed by or associated with Mozza.

28. If Registrant is granted continued registration of Registrant's Mark, Registrant will maintain a *prima facie* exclusive right to use the Registered Mark, and such continued registration would be the source of irreparable damage and injury to Mozza.

29. Accordingly, the Registered Mark should be cancelled under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), as amended.

COUNT II - DILUTION

30. Mozza repeats and realleges the allegation of paragraphs 1 through 29 above, as though fully set forth herein.

31. Registrant's commercial use of the Registered Mark in United States commerce in connection with restaurant and bar services dilutes, or is likely to dilute, the distinctive quality and reputation of the MOZZA Marks under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

32. Upon information and belief, Registrant's use of the Registered Mark commenced after the date on which Petitioner's MOZZA Marks became famous.

33. If Registrant is permitted continued use and registration of the Registered Mark in connection with restaurant and bar services, dilution of the distinctive quality and reputation of Mozza's famous MOZZA Marks would result in irreparable damage and injury to Mozza.

34. Accordingly, Registrant's Mark should be cancelled under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), as amended.

COUNT III – FRAUD ON THE PATENT AND TRADEMARK OFFICE

35. Mozza repeats and realleges the allegations of paragraphs 1-34 above, as though fully set forth herein.

36. Registrant made a false representation to the USPTO when it stated under oath at the time it filed its Declaration of Use and Incontestability that there was no proceeding involving its rights in the Registered Mark pending in the USPTO and not finally disposed of.

37. Registrant's false representation is material to the registrability of the mark.

38. Upon information and belief, Registrant had knowledge of the falsity of the representation at the time it was made or immediately thereafter.

39. Upon information and belief, Registrant made the false representation with the intent to deceive the USPTO or, after learning that the statement was false, adopted the false representation with the intent to deceive the USPTO.

40. Accordingly, Registrant's Mark should be cancelled under Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3), and Registrant's Declaration of Incontestability should be deemed withdrawn during the pendency of this proceeding and refused if later re-filed.

PRAYER FOR RELIEF

WHEREFORE, Petitioner Mozza, LLC prays that the mark shown in U.S. Registration No. 3,975,466 be cancelled, that the Declaration of Incontestability filed by Registrant be deemed withdrawn during the pendency of this proceeding and refused if later re-filed, and that this cancellation proceeding be sustained in Petitioner's favor.

Dated: August 23, 2016

Respectfully submitted,

COZEN O'CONNOR

/s/ Lisa A. Ferrari

Lisa A. Ferrari

277 Park Avenue

New York, NY 10172

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Email: lferrari@cozen.com

Attorneys for Petitioner Mozza, LLC

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that on August 23, 2016, a copy of the foregoing **AMENDED PETITION FOR CANCELLATION**, with attached **EXHIBIT A**, is being electronically filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, at <http://estta.uspto.gov/>.

/s/ Lisa A. Ferrari

CERTIFICATE OF SERVICE

I hereby certify that on August 23, 2016, copies of the foregoing **AMENDED PETITION FOR CANCELLATION**, with attached **EXHIBIT A**, have been served upon Registrant, addressed as follows:

Via electronic delivery (pursuant to agreement)
Larrin Bergman, Esq.
KINNEY & LANGE, P.A.
The Kinney & Lange Building
312 South Third Street
Minneapolis, Minnesota 55415-1002
Email: LBergman@kinney.com

Attorneys for Registrant Parasole IP, LLC

/s/ Lisa A. Ferrari

EXHIBIT A

Boezi, Mark

From: Ferrari, Lisa
Sent: Monday, June 6, 2016 7:42 PM
To: jforbes@felhaber.com
Cc: Boezi, Mark
Subject: Mozza, LLC v. Parasole IP, LLC: Petition to Cancel
Attachments: MOZZA MIA Petition for Cancellation.pdf

Dear Counsel:

Please see courtesy copy of Petition to Cancel filed today in the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board.

Sincerely,

/Lisa A. Ferrari/



Lisa A. Ferrari
Member | Cozen O'Connor
277 Park Avenue | New York, NY 10172
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 3,975,466

Registered: June 7, 2011

Mark: MOZZA MIA

MOZZA, LLC,

Petitioner,

v.

PARASOLE IP, LLC,

Registrant.

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Cancellation No. 92/063,839

**PETITIONER'S BRIEF IN SUPPORT OF
MOTION FOR LEAVE TO FILE
AMENDED PETITION FOR CANCELLATION**

Petitioner MOZZA, LLC ("Mozza" or "Petitioner") seeks leave to file an Amended Petition for Cancellation against Registrant Parasole IP, LLC ("Parasole" or "Registrant") to assert a claim of fraud based on facts that have come to Petitioner's attention within the last few days.

Specifically, on Thursday, August 18, 2016, in the course of investigating the database records of the U.S. Patent and Trademark Office ("USPTO") concerning Registrant's mark, Petitioner discovered that Registrant filed a Declaration of Incontestability on June 7, 2016, notwithstanding Petitioner's filing of its Petition to Cancel on June 6, 2016, one day earlier. In order to file its Declaration of Incontestability, Registrant was required to, and did, state in a declaration under oath that "... no proceeding involving said [trademark] rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exist." That statement

was false and, upon information and belief, was known to Petitioner to be false at the time it was made. Because the discovery period in this cancellation proceeding has just opened and neither party has yet served discovery, there would be no prejudice to Registrant in granting Petitioner's motion, and leave to amend should be granted.

I. FACTS

Petitioner filed an initial Petition to Cancel with the Trademark Trial and Appeal Board ("TTAB") on June 6, 2016, seeking to cancel Registrant's U.S. Registration No. 3,975,466 for the mark MOZZA MIA (the "MOZZA MIA Mark"). In addition to serving Registrant and its trademark counsel by U.S. Mail, Petitioner sent an email to Registrant's trademark counsel attaching the Petition to Cancel and informing counsel that the Petition had been filed. *See* Exhibit A to proposed Amended Petition for Cancellation.

Notwithstanding Petitioner's filing, one day later, on June 7, 2016, Registrant filed a Declaration of Use and Incontestability, pursuant to the Lanham Act, Sections 8 and 15, in connection with the MOZZA MIA Mark. In the Section 15 Declaration, Registrant stated under oath that ". . . no proceeding involving said [trademark] rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exist." Said statement was false at the time it was made, given Petitioner's filing of the Petition to Cancel the day before. Upon information and belief, Registrant knew that the statement was false at the time it was made because of the email sent by Petitioner on June 6th informing Registrant of the Petition to Cancel and providing a copy thereof.

Where a party has filed an inaccurate Declaration of Incontestability, the owner may file a petition to the Director pursuant to 37 C.F.R. § 2.167(j) requesting that the Declaration be

abandoned. Registrant did not file such a petition, however, and instead allowed the Declaration to remain in the USPTO records, unbeknownst to Petitioner. The Declaration was improperly accepted by the USPTO's Post-Registration Unit on August 19, 2016, more than two months after the Declaration of Incontestability had been filed. During that time, Registrant filed an Answer to the Petition to Cancel and participated in the initial discovery conference, thus eliminating any doubt that Registrant was on notice that it had filed a false statement in its Declaration of Incontestability.

Petitioner learned of Registrant's improper filing in a check of the PTO website on August 18, 2016, and filed this motion less than one week later.

II. LEGAL ARGUMENT

"Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court." 37 CFR § 2.115; *see also* TBMP § 507. In federal district courts, amendments to pleadings are governed by Federal Rule of Civil Procedure 15, which provides in pertinent part that "[t]he court shall freely give leave when justice so requires." Also, as set forth in TBMP § 507.02 & n.5 (citing cases),

[T]he Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint.

Here, justice requires that Petitioner be permitted to amend its Petition to Cancel so as to state a claim of fraud. Registrant made a false statement under oath concerning its registration when it stated in its Declaration of Incontestability that no proceedings concerning Registrant's rights in its registration existed. Obtaining incontestability confers important benefits to the

owner of a registration: the registration is conclusive evidence of the validity of the registered mark and its registration, of the registrant's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce, subject to certain defenses and exceptions. 15 U.S.C. § 1115(b). The statement that there are no pending proceedings concerning the registration is one of three statements that must be made the USPTO in the Declaration of Incontestability; it is undisputedly material to the USPTO's acceptance of the Declaration and the awarding of the important benefits conferred by the Lanham Act.

Upon information and belief, Registrant had knowledge of the falsity of the statement at the time it was made based on the email sent to Registrant's trademark counsel the day before Registrant's filing. At a minimum, Registrant at least obtained knowledge that the statement was false within a short time thereafter. Registrant nonetheless took no steps to withdraw or abandon the improperly filed Declaration as it could, and should, have done. *See* 37 C.F.R. § 2.167(j) (authorizing Petition to Director to request that improperly filed declaration of incontestability be abandoned). Last, upon information and belief, given Registrant's failure to abandon the Declaration at any time after filing it, Registrant made the false statement with the intent to deceive the USPTO to accept the Declaration of Incontestability and confer on it the important benefits of incontestability. Petitioner has thus stated a claim for fraud that does not violate settled law, and the amendment should be permitted. *See In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009).

Finally, entry of the proposed amendment at this preliminary stage of the proceedings is not prejudicial to Registrant. The discovery period just commenced, on August 16, 2016, and as of this date, only the initial discovery conference has been held; neither party has yet served discovery. The deadline for Initial Disclosures is not until September 15, 2016. Moreover,

Registrant did not delay, but promptly filed this motion within one week of learning of the improper filing. At this early stage of the proceeding, there would be no prejudice to Registrant were the Board to allow the amendment.

III. CONCLUSION

Based on the foregoing, Petitioner requests leave to file the Amended Petition for Cancellation submitted herewith, and requests that the Board enter an Order deeming the Amended Petition for Cancellation filed as of the date of this motion.

Dated: August 23, 2016

Respectfully submitted,

COZEN O'CONNOR

/s/ Lisa A. Ferrari

Lisa A. Ferrari

277 Park Avenue

New York, NY 10172

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Attorneys for Petitioner Mozza, LLC

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that on August 23, 2016, a copy of the foregoing **PETITIONER'S BRIEF IN SUPPORT OF MOTION FOR LEAVE TO FILE AMENDED PETITION FOR CANCELLATION** is being electronically filed with the United States Patent and Trademark Office, Trademark Trial and Appeal Board, at <http://estta.uspto.gov/>.

/s/ Lisa A. Ferrari

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Via electronic delivery (pursuant to agreement)
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Minneapolis, Minnesota 55415-1002
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Attorneys for Registrant Parasole IP, LLC

/s/ Lisa A. Ferrari